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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,357	03/12/2004	Elyse Clark	K8098.0000/P017	5610
24998	7590	05/17/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 2101 L Street, NW Washington, DC 20037			PASCUA, JES F	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/798,357

Applicant(s)

CLARK, ELYSE

Examiner

Jes F. Pascua

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-19 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-19 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 16-19 and 22-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,890,102 in view of Boyn. U.S. Patent No. 6,890,102 discloses the claimed device except for the bag panels containing a closure device. Boyn discloses that it is known in the art to provide handle bags with a closure device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the bag panels of U.S. Patent No. 6,890,102 with the closure device of Boyn, in order to close the opening of the bag.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16-19 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Springer et al. (See Fig. 5.), Boyn, Romer and admitted prior art.

Springer et al. discloses the claimed device except for the bag panels containing a closure device. Boyn discloses that it is known in the art to provide handle bags with a closure device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the bag panels of Springer et al. with the closure device of Boyn, in order to close the opening of the bag.

Furthermore, Springer et al. and Boyn disclose the claimed invention, as discussed above, except for napped material forming the entire outward facing surface of the gift bag. Romer discloses that it is known in the art to form the entire outward facing surface of an analogous bag with a decorative material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the entire outward facing surface of the Springer et al. bag with the napped material, in order to provide completely decorative bag.

Regarding claim 22, Springer et al. and Boyn disclose the claimed invention, as discussed above, except for a card with printed information being attached to at least one of the handles. Applicant's remarks in the response filed 03/28/2005 do not specifically address this rejection. Applicant's silence is considered an admission that it was known in the art that a card with printed information attached to the handle of a gift bag conveys a sentiment to the recipient of the gift bag. Therefore, it would have been

an obvious matter of design choice to attach a card with printed information to one of the handles in the gift bag of Springer et al.

Regarding claims 17 and 18, Springer et al. and Boyn disclose the claimed invention especially the material formed on the outward facing surface of the bag being a pile or nap. However, Springer et al. does not disclose the pile being short or long. Applicant's remarks in the response filed 03/28/2005 do not specifically address this rejection. Therefore, applicant's silence is considered an admission that a change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been an obvious matter of design choice to make the pile of Springer et al. short or long, since such a modification would have involved a mere change in the size of a component.

Response to Arguments

5. Applicant's arguments filed 03/28/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that U.S. Application Serial No. 10/405,468, now U.S. Patent No. 6,890,102, includes additional structure not required by applicant's invention, it must be noted that U.S. Patent No. 6,890,102 discloses the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant. Moreover, the rejection of the claims as being unpatentable over U.S. Patent No. 6,890,102 and Boyn is an issue of obviousness, not anticipation as discussed by applicant.

The application of Romer in the present Office action is in response to applicant's challenge of the Examiner's Official Notice that it would have been obvious to provide the entire outwardly facing surface of the Springer et al. gift bag with a napped filamentary material.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 571-272-4546. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 571-272-4549. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jes F. Pascua
Primary Examiner
Art Unit 3727

JFP